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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,130	09/01/2000	Imam Emami	454313-3156	8158
20999	7590	02/25/2005		
FROMMER LAWRENCE & HAUG 745.FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER WALLS, DIONNE A	
			ART UNIT	PAPER NUMBER

1731

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

**Office Action Summary**

Application No.

09/582,130

Applicant(s)

EMAMI, IMAM

Examiner

Dionne A. Walls

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicant has recited that the "extract is an alcoholic solvent or an aqueous alcoholic solvent" (emphasis added); however, there seems to be no support in the disclosure for such a recitation. In various places throughout the instant specification, Applicant discloses that the extract "can be obtained by extraction with" an alcoholic or aqueous alcoholic solvent (see page 2, line 16-18), or that the extract can be "dissolved in a solvent" (see page 3, lines 9-10), or that the extract can be in the form of "an aqueous alcoholic plant extract" (see page 3, line 13). However, there appears to be no support for claiming that the extract is an alcoholic solvent. Correction, or cancellation of the claim, is requested.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23-24, 27-32 are rejected under 35 U.S.C. 103(a) as being obvious over FR 2564296 in view of either Greaves et al (US. Pat. App. Pub. 2003/0049332) or Piquer et al (US. Pat. No. 6,326,504) and Yanishlieva-Maslarova et al ("Sources of Natural Antioxidants").

5. FR 2564296 discloses a cigarette filter, and a process for preparing same, wherein the cigarette filter is impregnated with essential oil of rosemary (see English abstract). While the FR 2564296 reference may not disclose that this oil is an extract, i.e. was obtained by extracting rosemary with a solvent, both Greaves et al and Piquer et al teach that essential oils can be isolated from the rosemary plant by extraction with an organic solvent (see Greaves et al – abstract; see Piquer et al – col. 4, lines 35-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have isolated rosemary oil from the plant by the extraction process, since this is a well-known way of producing the oil, and, hence, would obviously provide for an extract of rosemary for the filter of FR 2564296. Also, while the process of FR 2564296 modified by Greaves et al or Piquer et al may not disclose that the oil of rosemary contains polyphenols selected from the group consisting of extract of rosemary, carnosol, rosmanol, carnosic acid, and rosmarinic acid, Yanishlieva-Maslarova et al ("Sources of Natural Antioxidants") discloses that rosemary, and its extracts, contain carnosol, carnosic acid, rosmanol and rosmarinic acid (see pages 227-231). Therefore, it follows that the essential oil of rosemary which is added to the

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cigarette filter of FR 2564296 modified by Greaves et al or Piquer et al would obviously contain all of the above listed polyphenols. Lastly, although the combined references may be silent with respect the disclosed filter reducing free-radicals from cigarette smoke, the fact that Applicant has recognized this advantage in using an extract of rosemary in a cigarette filter, this advantage would flow naturally from following the suggestion of the prior art and, therefore, cannot be the basis for patentability since the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Regarding claims 30-31, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the claimed amount of polyphenol to the filter, after routine experimentation, in order to arrive at the optimal amount to produce the desired anti-septic effects of the oils.

### ***Response to Arguments***

6. Applicant's arguments filed July 21, 2004 have been fully considered but they are, in part, rendered moot based on the new grounds for rejection. Those arguments that still remain, the Examiner believes, have been fully addressed in the above paragraph.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

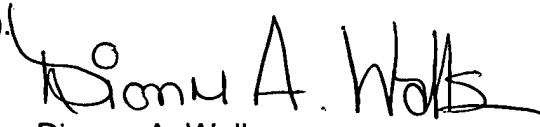
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dionne A. Walls  
Primary Examiner  
Art Unit 1731

February 16, 2005